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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,259	03/15/2004	Michael Berthon-Jones	3869-013US6	2254

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EXAMINER	
LEWIS, AARON J	

ART UNIT	PAPER NUMBER
3743	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,259	BERTHON-JONES, MICHAEL	
	Examiner	Art Unit	
	AARON J. LEWIS	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

ADP 6/24/05

2. Claims 22-~~31~~ 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,575,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 22 and patent claim 1 lies in the fact that patent claim 1 recites the step of "...estimating respiratory airflow..." whereas application claim 22 recites the step of "...determining a measure of respiratory airflow...". The use of the word "estimate" in patent claim 1 connotes a method that one of ordinary skill would have used to arrive at a figure which represents an approximation of a patient's respiratory airflow whereas the use of the words "determining a measure" connotes a method that one of ordinary skill would have used to arrive at a value that represents a patient's respiratory airflow. Inasmuch as an estimation may be consistent with a measured determination of respiratory airflow or may not differ significantly in any

manner which would yield unsatisfactory results, the two methods of arriving at respiratory airflow are functionally equivalent methods of achieving the same result and as such are obvious variants.

3. Claims 29 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 9 of U.S. Patent No. 6,575,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 29 and patent claim 8 lies in the fact that patent claim 8 recites the step of "...estimating respiratory airflow..." whereas application claim 29 recites the step of "...determining a measure of airflow...". The use of the word "estimate" in patent claim 8 connotes a method that one of ordinary skill would have used to arrive at a figure which represents an approximation of a patient's respiratory airflow whereas the use of the words "determining a measure" connotes a method that one of ordinary skill would have used to arrive at a value that represents a patient's airflow. Inasmuch as an estimation may be consistent with a measured determination of respiratory airflow or may not differ significantly in any manner which would yield unsatisfactory results, the two methods of arriving at respiratory airflow are functionally equivalent methods of achieving the same result and as such are obvious variants.

4. Claims 31-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-12 of U.S. Patent No. 6,575,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 31 and patent claim 10

lies in the fact that patent claim 10 includes more elements (e.g. claim 10 recites the additional elements of "a means for delivering ventilatory support to a patient") and is thus more specific. Thus the invention of claim 10 is in effect a "species" of the "generic" invention of claim 31. It has been held that the generic invention is "anticipated" by the "species". See In re Goodman, 29 USPQ2d 2010 (Fed. Cir.1993). Since claim 31 is anticipated by patent claim 10, it is not patentably distinct from patent claim 10.

5. Claims 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-15 of U.S. Patent No. 6,575,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 34 and patent claim 13 lies in the fact that patent claim 13 includes more elements (e.g. claim 13 recites the additional elements of "a flow signal representing respiratory airflow" whereas application claim 34 recites "a flow signal representing at least in part respiratory airflow") and is thus more specific. Thus the invention of claim 13 is in effect a "species" of the "generic" invention of claim 34. It has been held that the generic invention is "anticipated" by the "species". See In re Goodman, 29 USPQ2d 2010 (Fed. Cir.1993). Since claim 34 is anticipated by patent claim 13, it is not patentably distinct from patent claim 13.

6. Claims 38-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-15 of U.S. Patent No. 6,575,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claim 34 and patent claim 13

lies in the fact that patent claim 13 includes more elements (e.g. claim 13 recites the transducer generates a signal "representing respiratory airflow" whereas application calim 38 recites the transducer generating of a "flow signal"; claim 13 recites a processor coupled to the transducer and servo-controller and being provided "with programmed instructions" whereas application claim 38 recites a processor coupled to the transducer and servo-controller; claim 13 recites the "instructions calculate instantaneous inspired volume as function of both the respiratory airflow" whereas application claim 38 recites the processor is configured and adapted for calculating instantaneous inspired volume and a function of both data from the flow signal") and is thus more specific. Thus the invention of claim 13 is in effect a "species" of the "generic" invention of claim 34. It has been held that the generic invention is "anticipated" by the "species". See In re Goodman, 29 USPQ2d 2010 (Fed. Cir.1993). Since claim 34 is anticipated by patent claim 13, it is not patentably distinct from patent claim 13.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. LEWIS whose telephone number is (571) 272-4795. The examiner can normally be reached on 9:30AM-6:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HENRY A. BENNETT can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AARON J. LEWIS
Primary Examiner
Art Unit 3743

Aaron J. Lewis
June 24, 2005